

REMARKS/ARGUMENTS

Claims 34, 36, 40 and 42 were rejected under 35 U.S.C. § 102(b) as being anticipated by Snyder et al (U.S. Patent No. 5,784,444, hereinafter, "Snyder").

Independent claim 34 calls for a memory having stored therein a plurality of predetermined messages to replace the caller ID value for the telephone at which the calling card is used. Similarly, independent claim 40 calls for a memory having stored therein a plurality of predetermined messages, one or more of said plurality of messages to be received by a recipient communication device in place of the respective caller ID value of a telephone at which the calling card is used. To anticipate a claim, "a reference must disclose every element of the challenged claim." *See, PPG Inc. v. Guardian Indus. Corp.*, 37 U.S.P.Q. 2d 1618, 1624 (Fed. Cir. 1996). Further, to anticipate, the elements must be arranged as in the claim. *See e.g., Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d, 1452, 1458 (Fed. Cir. 1984).

Snyder does not teach replacing the caller ID value or receiving a predetermined message in place of a caller ID value. Rather, Snyder teaches supplementing a caller ID value. See column 1, line 66 through column 2, line 2. For example, pursuant to Snyder, a telephone station "T" may include a display (34, 36) on which a display screen (200, 250) may appear. Figures 6 and 6A; column 3, lines 1-3; column 4, lines 21-23; column 5, lines 16-20. Generally, information may be displayed on the display screen, including the telephone number of the sending telephone station. Figure 6, 202. This information, including the caller ID number, is also displayed on the recipient machine. See Figure 6A, 256; column 5, lines 16-32. Therefore, Snyder does not disclose replacing the caller ID value. As such, Snyder does not anticipate independent claims 30 and 34 or the claims depending therefrom.

Replacing rather than supplementing a caller ID value is advantageous in that many existing telephone displays cannot accommodate a large body of information as shown in Snyder. Figures 6, 6A. In fact, Snyder's system 10 utilizes telephone stations that include dial

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pads and keyboards for user entry of the information. Column 4, lines 38-46. In contrast, a keyboard for user entry of information is not required according to some embodiments of the present invention. Thus, embodiments of the present invention have an advantage over Snyder.

Claims 28 and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tasaki et al. (U.S. Patent No. 4,879,744, hereinafter, "Tasaki") in view of Snyder.

Independent claim 28 calls for a memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. The Examiner concedes that Tasaki fails to teach this limitation. See Paper No. 14, page 4. However, as explained above, neither does Snyder. Thus, the combination of Tasaki and Snyder does not teach each and every limitation as required to render claims 28, 30-32 unpatentable.

Further, there is no suggestion, motivation or teaching of the desirability to make the specific combination made by the Applicant. Without the suggestion, motivation or teaching of the desirability of making the claimed combination, even if all claim parts are identified, the claim still is not obvious. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The Examiner merely concludes based on inappropriate hindsight that it would be obvious to incorporate teachings of Snyder into Tasaki. Paper No. 14, page 4. That is, the Examiner has not provided evidence, or particular findings to support the stated conclusion. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (particular findings relating to the suggestion, motivation or teaching must be provided, conclusory statements standing alone are not evidence). Moreover, as explained above, even if there were a motivation, suggestion or teaching to incorporate the teachings of Snyder into Tasaki, which there is not, the combination still would not teach each and every limitation as claimed.

For at least the reasons stated above, it is respectfully requested that the rejection of each claim in the application be withdrawn and the Examiner allow the application to pass to issue.

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The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0785US).

Respectfully submitted,



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